

REMARKS

Claims 1, 3, and 9-11, have been amended. Support for the amendments to Claims 1 and 9-11 are throughout the specification, for example paragraphs [0010] - [0015] of the specification as published. Claim 3 is amended to remove non-essential features and therefore no new matter is added. No new matter is added by the amendments.

Upon entry of the amendments, Claims 1-3, 7-11, and 14-15 are pending.

Rejection of Claim 1-3, 7-11, and 14-15 under 35 U.S.C. § 112, first paragraph

The Office Action rejects Claims 1-4, 7-11, and 14-15 for failing to comply with the written description requirement. In particular, the Office Action asserts “there is no support for broadly reciting poly-L-lactic acid polymer.” Without acquiescing to the rejection, but in order to expedite prosecution, Applicants have amended Claims 1 and 10 to recite, *inter alia*, “poly-L-lactic acid polymer having a glass transition temperature of 55° to 80° C.” Applicants believe the amendments overcome the rejection. Withdrawal of the rejection is respectfully requested.

Rejection of Claim 1-3 and 7-9 under 35 U.S.C. § 103

The Office Action rejects Claims 1-3 and 7-9 as obvious over Gin et al. (U.S. Publication No. 2004/0247669) in view of Bunczek et al. (U.S. Patent No. 6,013,287). In particular, the Office Action asserts Gin teaches gum bases having poly-L-lactic acid polymer, and Bunczek teaches gum bases including acetylated monoglyceride.

Applicants respectfully submit Claims 1-3 and 7-9 are non-obvious over the cited references for at least two reasons: (1) Gin is not prior art to the present application under the present rejection, and (2) the references of record, as a whole, teach away from poly-L-lactic acid.

Gin is Not Prior Art

Gin is not prior art under 35 U.S.C. §102(a), (b) or (e). With respect to 35 U.S.C. §102(a) and (b), Gin published December 9, 2004. The present application is the national phase of P.C.T. Application No. PCT/IB03/03889, filed July 22, 2003. Therefore, Applicants’ filing date is before Gin’s publication. Consequently, Gin is not prior art under 35 U.S.C. §102(a) or (b).

Application No.: 10/521,925
Filing Date: August 16, 2005

With regard to 35 U.S.C. §102(e), Gin's earliest priority date is later than the priority date to which the claims of this application are entitled, and, therefore, Gin is not prior art. Gin claims priority to an U.S. Application No. 10/358,602, filed February 4, 2003. The present application claims priority to Japanese Patent Application No. 2002-215615, filed July 24, 2002. Thus, Gin's earliest priority date is later than the filing date of priority Japanese Patent Application No. 2002-215615.

A certified copy of Japanese Patent Application No. 2002-215615 was filed in the instant application on March 28, 2005, and, therefore, is of record in this case. A verified translation into English of Japanese Patent Application No. 2002-215615 is attached as Exhibit 1. As is clear from the English translation of Japanese Patent Application No. 2002-215615, the claims as pending are fully supported by Japanese Patent Application No. 2002-215615. As such, in accordance with M.P.E.P. § 706.02(b), Applicants have established that the claims as pending are entitled to claim priority to Japanese Patent Application No. 2002-215615. Thus, the claims as pending are entitled to a priority date of July 24, 2002. Since Gin earliest priority date is after Applicants' priority date, Gin cannot serve as prior art under 35 U.S.C. § 102(e).

Accordingly, Gin is not prior art to the present application under the present rejection because Gin is not prior art under 35 U.S.C. §102(a), (b) or (e) for the present rejection. Meanwhile, Bunczek fails to disclose all features of the claims, and therefore cannot alone render the claimed subject matter obvious. Therefore, the calims are non-obvious over the cited references.

The References of Record Teach Away from Poly-L-Lactic Acid in Chewing Gums

Applicants respectfully submit the references of record, as a whole, teach away from poly-L-lactic acid in chewing gums. In particular, the PTO already acknowledges that Li (WO 2000/19837) teaches away from using poly-L-lactic acid in chewing gums. *Office Action, dated July 8, 2009* at 8. Meanwhile, Gin merely discloses poly-L-lactic acid in a large list of possible polymers that might be useful for chewing gums or lozenges. “The decision on patentability must be made based upon consideration of all the evidence...” M.P.E.P. §2142 (emphasis added). A person of ordinary skill, guided by the references of record, would still find poly-L-lactic acid to be unsuitable for chewing gums and conclude Gin merely teaches poly-L-lactic acid

for use in lozenges. Thus, all the evidence, as a whole, teaches away from poly-L-lactic acid in chewing gums.

Gin's Teachings regarding Poly-L-Lactic Acid are Not Specific to Chewing Gum

The Office Action asserts Gin teaches chewing gums having poly-L-lactic acid. But Gin provides no specific teaching that this polymer is suitable in chewing gums. Gin merely teaches a large list of hydrophilic polymers—of which poly-L-lactic acid is one possible polymer—that might be useful in chewing gums or lozenges. Gin at Abstract, paragraphs [0035] – [0037]. Thus, Gin fails to teach that poly-L-lactic acid is suitable for chewing gums.

None of Gin's examples teach chewing gums having poly-L-lactic acid. Indeed, the Office Action relies upon Gin's chewing gums with a different hydrophilic polymer, ETHOCEL Standard 45 Premium, to reject the claims. *Office Action* at 3; *see also* Gin at paragraph [0184] – [0195]. As such, Gin provides no working examples showing poly-L-lactic acid in a chewing gum. Gin therefore provides no basis for determining if poly-L-lactic acid is suitable in a lozenge, chewing gum, or both. Rather, a person of ordinary skill must experiment to determine if poly-L-lactic acid is suitable.

Accordingly, Gin, at best, is ambiguous regarding the use of poly-L-lactic acid in chewing gum. A person of ordinary skill must select poly-L-lactic acid from a large list of possible polymers, and then experiment to determine if the poly-L-lactic acid actually works in a chewing gum, lozenge or both.

Li Teaches a Person of Ordinary Skill to Select a Different Polymer for Chewing Gum

A person of ordinary skill, guided by the combined teaching of Gin and Li, would not select poly-L-lactic acid for use in a chewing gum. Rather, a person of ordinary skill would select one of the other polymers taught by Gin.

The PTO previously rejected claims over Li, but now acknowledges that Li teaches poly-L-lactic acid to be unsuitable for chewing gums. *Office Action, dated July 8, 2009* at 8. Moreover, unlike Gin, Li's teachings are specific to chewing gum. Thus, the reference unequivocally discourages a person of ordinary skill from incorporating poly-L-lactic acid into chewing gum. Meanwhile, as discussed above, Gin provides a large list of possible hydrophilic polymers, without any specific guidance to use poly-L-lactic acid in a chewing gum. When these teachings are combined, a person of ordinary skill would have no reason to select poly-L-lactic

acid. One would likely conclude, in view of Li, that poly-L-lactic acid was intended for lozenges, not chewing gum. As such, one would select, for example, poly(D,L-lactic acid-co-glycolic acid) from Gin's list of polymers—not poly-L-lactic acid—because Li teaches this polymer can be suitable in chewing gums.

In summary, Gin's teachings are, at best, ambiguous with regards to using poly-L-lactic acid in chewing gum. In contrast, Li unequivocally teaches away from using poly-L-lactic acid in chewing gum. Accordingly, the references of record still lead a person of ordinary skill away from the claimed subject matter. Thus, even if Gin was prior art, the cited references do not render the claimed subject matter obvious.

For at least the reasons stated above, Claims 1-3 and 7-9 are non-obvious over the cited references. Withdrawal of the rejection is respectfully requested.

Allowable Subject Matter

The PTO previously identified allowable subject matter because Li teaches away from at least poly-L-lactic acid; however this subject matter is now rejected in view of new references. In view of the above arguments, Applicants maintain these claims should still be allowable subject matter.

Meanwhile, the Office Action does not reject Claims 10, 11, 14 and 15, and therefore Applicants also submit these claims are allowable subject matter.

If any remaining issues must be addressed prior to obtaining a notice of allowance, Applicants invite Examiner Gwartney to contact Applicants by telephone.

No Disclaimers or Disavowals

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicant is not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicant reserves the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution.

Application No.: 10/521,925
Filing Date: August 16, 2005

Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicant has made any disclaimers or disavowals of any subject matter supported by the present application.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: April 23, 2010

By: William H. Noon
William Noon
Registration No. 64,731
Attorney of Record
Customer No. 20,995
(619) 235-8550

8739883_1
042210